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OFFICE OF PETITIONS

In re Application of
Broussard, Milton, Bergeron, Remis,
Popovich & Volkar
Application No.: 10/629,887
Filed: July 29, 2003
Attorney Docket No.: DB000974-001
For: ARTICLE DISPENSING AND COUNTING
METHOD AND DEVICE

DECISION REFUSING STATUS
UNDER 37 CFR 1.47(a)

This is a decision on the petition under 37 CFR 1.47(b), filed February 2, 2004 (certificate of mailing date January 29, 2004). The petition will be treated under 37 CFR 1.47(a). Petitioners are reminded that when at least one joint inventor executes the declaration, the provisions of 37 CFR 1.47(a) apply. Where 37 CFR 1.47(a) is available, application cannot be made under 37 CFR 1.47(b). MPEP 409.03(b)

The petition under 37 CFR 1.47(a) is **DISMISSED**.

Any request for reconsideration of this decision must be submitted within **TWO (2) MONTHS** from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. Any response should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(a)" and may include an oath or declaration executed by the inventor. **Failure to respond will result in abandonment of the application.**

The above-identified application was filed on July 29, 2003 without an executed oath or declaration. Accordingly, on October 29, 2003, a "Notice to File Missing Parts of Nonprovisional Application" was mailed, requiring an executed oath or declaration, a surcharge for its late filing, and replacement drawings.

In response, on February 2, 2004 (certificate of mailing date November 29, 2004), a declaration executed by five of six joint inventors, an addendum to the declaration signed by a representative of the former employer of the non-signing inventor, replacement drawings, the surcharge, a one month extension of time with required fee, and the instant petition and required fee were filed. The petition sets forth non-signing inventor Bergeron's last known address. The exhibits to the petition show that Mr. Bergeron was not mailed a copy of the application because he would not execute a non-disclosure agreement. Mr. Bergeron states in a letter dated January 9, 2004, that he is not refusing to join in the filing of the application and would like to receive a copy of the application.

A grantable petition under 37 CFR 1.47(a) requires

- (1) a petition including proof of the pertinent facts establishing that the joint inventor(s) refuses to join, or cannot be found or reached after diligent effort,

- (2) a proper oath or Declaration executed by the available joint inventor(s),
- (3) the fee of \$130 as specified in 37 CFR § 1.17(h), and
- (4) the last known address of the omitted inventor(s).

This petition lacks item (1) above.

As to item (1), Applicants have failed to establish that Mr. Bergeron has refused to sign the declaration. Rather, Mr. Bergeron has explicitly stated that he has **not** refused to join in the filing of the application. Mr. Bergeron requested a copy of the application. The fact that an application may contain proprietary information does not relieve the 37 CFR 1.47 applicants of the responsibility to present the application papers to the inventor if the inventor is willing to receive the papers in order to sign the declaration. The Office requires that the non-signing inventor be provided with a complete copy of the application as filed. This includes the specification with claims, drawings, if any, and a declaration. See MPEP 409.03(d). Finding a refusal based on conduct is possible. However, more than one attempt to obtain the inventor's cooperation in the filing of the application is typically necessary. The proof of the pertinent events should be made by a statement of someone with first hand knowledge of the events.

With respect to the declaration, the addendum signed by a representative of Mr. Bergeron's former employer has no effect in a Rule 47(a) situation. The joint inventors have signed a valid declaration on behalf of Mr. Bergeron. The addendum will be retained in the application file.

Further correspondence with respect to this matter should be addressed as follows:

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